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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/036,720

11/08/2001

Maren Christensen

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11/14/2006

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EXAMINER

MOONEYHAM, JANICE A

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/036,720

Applicant(s)

CHRISTENSEN, MAREN

Examiner

Janice A. Mooneyham

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 September 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-29 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-29 and 31-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This is in response to the applicant's communication filed on September 8, 2006, wherein:

Claims 21-29, and 31-34 are currently pending;

Claims 1-20 and 30 have been canceled;

Claims 21, 27, and 28 have been amended;

Claims 31-34 have been added.

#### ***Response to Amendment***

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 21-29 and 31-34 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In particular, the disclosure is nothing more than generalities such as assessing and categorizing various intellectual properties. The applicant uses questionnaires posing questions pertaining to intellectual property and then packages the one or more contract documents with the one or more questionnaires. It is unclear from the disclosure how the computer would be programmed, without undue experimentation, to convert text and essay questions and responses into computer data in order to take into

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account all of the subjective answers which the process appears to entail. Although the instant specification is replete with generalizations regarding the various factors to be taken into consideration, it is short on any specific direction or guidance as to actually gathering the necessary data, inputting the required data and programming a computer to achieve the desired results. Further, the specification lacks guidance as to how to use the data in maximizing the use of the assets. There is no indication in the specification of how the data is used to plan for all the potential uses of the properties and to maximize the use of the assets. For further examination the claims are interpreted in light of the 35 U.S.C. § 101, and 35 U.S.C. § 112, first paragraph rejection.

3. Claims 31 and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention,

Applicant has added the limitations of wherein the step of directing the review further comprises prompting selection of one or more special format answers, wherein the one or more than one contract document and the pertinent legal questions are sent via email and the responses are received via email, wherein the emails are encrypted and compresses, and wherein the step of routing the package for review further comprises prompting selection of one or more special format answers from pull-down boxes or radio buttons. The Examiner has performed a search of the disclosure and

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submits that there is not sufficient disclosure for these newly added limitations, thus, these limitations are new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 31 and 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what the applicant means by the step of directing the review further comprises prompting selection of one or more special format answers. Is the reviewer selecting the answers or the person directing the review? What are special format answers?

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 21-29 and 31-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 21-29 and 31-34 do not produce a "concrete" result in the "method for managing intellectual property rights or the method for managing ownership rights in intellectual property rights". The steps in the present application do not produce

concrete results. It is unclear how the present application expresses the use of the questionnaires and how they are used in maximizing the use of the intellectual property assets.

The results of applicant's invention in arriving at a probable success factor for maximizing the use of the intellectual property assets is clearly not the same results found in *State Street Bank & Trust Co. V. Signature Financial group, Inc.*, 149 F 3d 1371; 47 USPQ 2d 1599 decided by the U.S. Courts of Appeals. "Today we hold the transformation of data representing discrete dollar amounts by a machine through a series of mathematical calculations into a final share price constitutes a practical application of a mathematical algorithm, formula or calculation because it produces a useful, concrete and tangible result, a final share price momentarily fixed for recording and reporting purposes". In the State Street case the "concrete, tangible, and useful results" is allocating money to different funds.

In the *AT&T v. Excel Communications* the useful, concrete, and tangible results is the claimed step of "producing message record for long distance telephone calls, enhanced by addition of Primary Interexchange Carrier (PIC) indicator", the system performs different calculations and the result facilitates differential billing of calls made by the subscriber to long distance service carrier.

The definition of concrete is particular and specific, not general. In the present application, the disclosure is nothing more than generalities as to gathering, assessing and categorizing various intellectual properties. However, the disclosure is short on specifics as to explicitly how the contracts and the questionnaires are packaged or how

the pertinent legal questions are generated or what criteria is used to link the data records or what determines how the hierarchical tree is generated which represents the linkage between the data records and the pertinent legal questions. There appears to be many variables and subjective determination made at each step. Furthermore, it is unclear from the disclosure how the computer would be programmed, without undue experimentation, to convert text and essay questions and responses into computer data in order to take into account all of these subjective factors which the process appears to entail. Although the instant specification is replete with generalizations regarding the various factors to be taken into consideration, it is short on any specific direction or guidance as to actually gathering the necessary data, inputting the required data and programming a computer to achieve the desired results. Further, the specification lacks guidance as to how to use the data in maximizing the use of the assets.

Applicant discloses on page 20 of the specification that the packaging module will be operated by an individual who may be referred to as the packager to emphasize that the individual who operates the packaging module may be different from the person or persons who operate the remaining modules. Applicant states that a packager operates the packaging module, a reviewer operates the reviewing module and a searcher operates the search module. The applicant discloses that the packager and the searcher can be the same person and that the reviewer can be an attorney (page 20, lines 26-33). There appears to be considerable subjective determination in the invention. Therefore, it is clear from the definition of "concrete" and the analysis of the disclosure and the claimed limitations of the present invention mentioned above that the

disclosure of the present invention is nothing more than generalizations regarding the various factors to be taken into consideration, and it is short on any particular or specific direction or guidance in achieving the desired results and in providing a concrete result. Consequently, the claims are analyzed based upon the underlying process and thus rejected as being directed to a non-statutory process.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 21-22 and 26-27 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Rivette et. al (US 2003/0046307) (hereinafter referred to as Rivette).

Referring to Claim 21:

Rivette discloses method for managing intellectual property rights in an intellectual property arising from one or more than one contract document, comprising:

packaging the one or more than one contract document and pertinent legal questions comprising one or more than one legal question pertaining to the intellectual property ( Figure 102 (10210) See also Figure 1 (116), Figure 2 (214), Figures 68-70, figure 95 (9516), Figure 109, Figure 114, [0020] [0025] [0253-0254]);



directing the review of the one or more than one contract documents and acquisition of acquired responses to the pertinent legal questions (Figure 102 (10210), Figure 104-110), Figure 108 (10808-10810); and

storing the acquired responses in a database to permit searching the acquired responses (Figure 149(14918), [0402] [0277] [0305]).

Referring to Claim 22 and 26:

Rivette discloses a method wherein the packaging step comprises the steps of: initializing a management program and creating data records comprising one or more than one data records having information pertaining to the intellectual property (Figures 1-186);

generating the pertinent legal questions (102 (10210), Figure 105 (10508-10510));

linking the data records to the pertinent legal questions (Figure 95 (9516), Figure 105 (10506-10510), Figure 139 (13910);

displaying a hierarchical tree representing the linkage between the data records and the pertinent legal questions (Figures 18, 65, 71A, 72-73, 86 (8612) Figure 157); and

routing the one or more than one contract document, the pertinent legal questions and the data records to a reviewer (Figure 101 (10110)).

Referring to Claim 27:

Rivitte discloses a method for managing intellectual property rights in an intellectual property arising from one or more than one contract document, comprising:

processing and displaying information pertinent to the intellectual property ([0253-0254]; posing legal questions pertaining to the intellectual property (Figure 102 (10210); processing, via a central processor via stored management program, wherein the management program performs the steps of packaging the one or more contract documents and the legal questions, reviewing the one or more contract documents and the acquired responses to the legal question and searching the acquired responses; and displaying information pertinent to the intellectual property (Figures 103-110, Figure 176).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 23-25 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette in view of Martin (US 6,330,547) (hereinafter referred to as Martin).

Referring to claims 23 and 24:

Rivette does not disclose wherein the generating step comprises offering choice of rights questionnaires.

However, Martin discloses questionnaires for gathering information pertaining to intellectual property assets (col. 5, lines 63-66).

It would have been obvious to one of ordinary skill in the art to incorporate into the patent information management method of Rivette the questionnaires taught in Martin so as guide the user to provide the complete data necessary to perform an analysis.

Referring to Claim 25:

Martin discloses a method, further comprising, eliciting critical information about ownership rights in the intellectual property (col. 8, lines 52-66).

Referring to Claim 28-29 and 34:

Rivette discloses method for managing ownership rights in an intellectual property arising from one or more contract documents [0897], comprising:

accessing a computer network (Figure 11);

initializing a management program and creating data records and preparing a package (Figures 3-12A)

routing the package for review (Figure 101 (10110)).

Rivette does not disclose wherein the generating step comprises offering choice of rights questionnaires or receiving response to the questionnaire.

However, Martin discloses questionnaires for gathering information pertaining to intellectual property assets (col. 5, lines 63-66).

It would have been obvious to one of ordinary skill in the art to incorporate into the patent information management method of Rivette the questionnaires taught in Martin so as guide the user to provide the complete data necessary to perform any analysis.

Claims 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette.

Rivette does not disclose sending legal questions via email and receiving responses via email or that the email is encrypted and compressed.

However, sending information by email is an old and well known way of communicating. Furthermore, as admitted by applicant in paragraph [0141], these techniques are known in the art.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the intellectual property analysis and management method of Rivette the ability to send and receive information via encrypted email since one skilled in the art at the time of the invention would have possessed this knowledge and skill and would utilize encrypted email as a way to provide quick, efficient and secure communication.

***Response to Arguments***

8. Applicant's arguments filed September 8, 2006 have been fully considered but they are not persuasive.

Rejection under 35 USC 112, First Paragraph:

The Examiner maintains the rejection for the reasons set forth in the discussion under the rejection.

Rejection under 35 USC 101:

The rejection under 101 is maintained for the reasons set forth in the discussion under the rejection.

Rejections under 35 USC 102:

Applicant states that independent claim 21 recites packaging one or more contract documents and pertinent legal questions pertaining to intellectual property and directing the review of the one or more contract documents and the one or more legal questions.

MPEP 2111 requires the Examiner to give the claim language the broadest reasonable interpretation in light of the specification without reading limitations into the claims. Applicant's claim language is very broad. The concept of packaging the contract document and legal questions can encompass any method of attaching a contract document, such as a license, with a legal question. The concept of a legal question is very broad, also. Thus, the Examiner is asserting that the question of whether a patent should be licensed or sold would qualify as a legal question.

As for applicant's argument that the change of the review module to a reviewer changes the scope of the claim, the Examiner respectfully disagrees. A reviewer can be human or non-human. Thus, any evaluation would be a review.

The concept of a legal source for review also is a broad concept. What defines a legal source? Thus, the Examiner submits that any evaluation of a license or a maintenance fee, or infringement would be review by a legal source of a legal question.

Applicant argues that neither Rivette nor Martin offer choice of rights questionnaires. Martin discloses offering questionnaires about IP rights and licenses. If applicant is arguing that the type questions in the questionnaire make applicant's invention novel or the type of questions in the questionnaire make the applicant's invention novel, the Examiner respectfully disagrees. Applicant states in claim 25 that the questionnaire elicits information about ownership rights in intellectual property. Thus, the Examiner asserts that Figure 4, (420), Martin discloses questions regarding ownership rights of intellectual property.

As for applicant's argument as to claim 28, the Examiner asserts that Rivette in combination with Martin disclose preparing information from a questionnaire, said information regarding licenses, and evaluating the information.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

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the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation comes from knowledge generally available to one of ordinary skill in the art.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

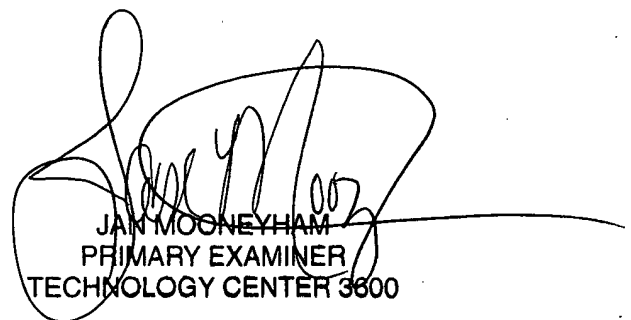


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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